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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/783,097	01/14/97	LAU	L ACS-40896

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.F3M1/0703

EXAMINER

BENNETT, C

ART UNIT	PAPER NUMBER
3307	6

DATE MAILED: 07/03/97

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/783,097</b>	Applicant(s) <b>Lau et al.</b>
	Examiner <b>Christopher A. Bennett</b>	Group Art Unit <b>3307</b>

Responsive to communication(s) filed on Jan 14, 1997

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1 and 25-37 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1 and 25-37 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### **DETAILED ACTION**

Initially, it is noted that the claims submitted in the Pre-Amendment filed on Jan. 14, 1997 have been misnumbered as claims 32-44. As the claims as originally filed are claims 1-24, the newly submitted claims should be numbered claims 25-37. Accordingly, these claims have been renumbered as claim 25-37 and will be referred to only as such.

1. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 25-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 5,514,154. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the contain all of the elements recited in the claims of the present application as well as additional limitations. Therefore, the claims of the present application are rendered obvious over the claims of the patent.

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***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 25-28 and 31-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schatz (US 5,195,984) in view of Tower (US 5,161,547).

Schatz teaches a stent for implanting in a body lumen comprising: a plurality of spaced apart cylindrical rings 70A, 70B, and 70C (Fig. 7) positioned along a longitudinal axis having a plurality of elements; a plurality of parallel connecting members 102; said cylindrical rings having an undulating shape in which element thereof are out of phase; said cylindrical rings and connecting members are formed from a single piece of hollow tubing; said connecting members between adjacent cylindrical elements are substantially the same length. To form the stent of Schatz out of a sheet of any metal alloy including stainless steel or nickel-titanium would have required nothing more than an obvious use of well-known material for making a stent. Further, there is no unobviousness in the number of cylindrical element which are connected. The selection of the number of cylindrical elements would depend upon the obvious determination of the length needed for a particular application for which the stent is being used. Schatz does not teach the undulating shape of the cylindrical elements being substantially U-shaped.

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Tower teaches the conventionality of using a U-shaped undulating pattern in which the individual U-shaped members are substantially the same shape and size.

To modify the cylindrical members of Schatz to have U-shaped members as taught by Tower or any other well-known suitable shaped would have required nothing more than an obvious substitution of one well-known suitably shaped cylindrical shaped for another.

*Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris A. Bennett whose telephone number is (703) 308-0980.

*Christopher A. Bennett*  
CHRISTOPHER A. BENNETT  
PRIMARY EXAMINER  
GROUP 3300

CAB

June 23, 1997